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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,136	01/16/2001	Terry Tam	8673-112 (8061-567 SJP/K1	3423
22150	7590	01/26/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			GEREZGIHER, YEMANE M	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,136

Applicant(s)

TAM, TERRY

Examiner

Yemane M Gerezgiher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 (Group I) & 17 (Group II) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/16/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been examined. Elected Group I (Claims 1-16) has been examined. Non-elected Claim 17 has been withdrawn from consideration

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 1-16:

*A Simple Supplementary Services Protocol (SSSP) for encoding Protocol Data Units (PDUs) which are carried via messages over an existing protocol for network communications, comprising:
an identifier field for identifying different functionally based supplementary services;
an end tag field for denoting message endings; and
a parameters extensions field separating said identifier field and said end tag field.*

a. The claim is directed to a non-statutory subject matter, which is merely a protocol that is not tangibly embodied on a computer readable medium so to be executable.

b. Further, the recited limitations are directed to a non-statutory subject matter because the limitations are

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directed to a non-functional descriptive material, which lack practical application.

c. The protocol namely "SSSP" comprising identifier fields identifying supplementary services ... and further detailing and limiting depending claims 2-16 fall under the same category. According to the patent law, claimed invention, as a whole must produce a "useful, concrete and tangible" result to have a practical application resulting in a useful, concrete, and tangible result where usefulness under patent eligibility requires considerable functionality present to complete useful outcome aspect of the practical application. See MPEP 2106 (Patentable Subject Matter - Computer-Related Inventions). The presented claims in this application failed to satisfy the requirement described above. Moreover the patent law requires that one may patent something that is **a machine, manufacture, composition of matter or a process**. However, "A Simple Supplementary Services Protocol (SSSP)" does not fall in any categories of process, machine, manufacture or composition of matter so to be given a patentability weight. Thus, Claims 1-16 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter for almost failing on all possible requirements of

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the 35 U.S.C. 101 rejections.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korpi et al. (U.S. Patent Number 6,621,814) in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

Korpi disclosed a method and apparatus for transmitting voice data in data packets with additional supplementary services (See Title). Korpi addressed the drawback of the standards that are approved very little by little by the ITU for additional supplementary services taking a long time before such standards are defined (See Column 2, Lines 30-44). Korpi disclosed a method of encoding additional supplementary services in a fashion compatible with the existing protocol of transmitting the existing standard supplementary services. See

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Column 3, Lines 27-62. Korpi taught that the ITU-T Standard H.323 allowing an expansion by new signaling protocol utilizing additional supplementary services where the protocol used is the existing H.323 protocol. See Column 5, Lines 40-49 and Column 1, Line 22 through Column 12, Line 16. Korpiu substantially disclosed the invention as claimed. However, Korpi was silent about the specifics of the PDUs encoding including identifier fields identifying functionally different supplementary service, the use of alphanumeric string encoding, the use of a comma and/or an asterisk as a ParameterSeparator, a protocol tag, the limited size of the characters used to describe multiple data fields.

PDU is commonly defined as "a message of a given protocol comprising payload and protocol-specific control information, typically contained in a header. PDUs pass over the protocol interfaces which exist between the layers of protocols (per OSI model)." Korpiu taught a method and apparatus of providing additional supplementary services that are compatible with the existing H.450.x standards. Since the teachings of Korpiu disclosed a method of providing additional supplementary services, the use of plurality of parameters was inherently disclosed. Further, since the disclosed teaching deals with the pluralities of parameters or the data/identifier fields the use

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of some parameter separator was inherent. Accordingly, the use of a "comma", "asterisk" as a parameter separator, limiting the size of the string or character to one or more in order to describe the message type and generally to define different sets of fields in encoding a PDU is an arbitrary preference which does not change the end-result of the invention as claimed.

An artisan working with the invention of Korpiu related to additional supplementary services that are compatible with the existing protocol would have realized that the implementation (reduction to practice) step would require an arbitrarily syntax selection, alphanumeric encoding, and selection of arbitrary characters to separate parameters or to indicate a message type and describe fields of data in the PDU. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention to make arbitrary choices of alphanumeric encoding and selection of arbitrary characters and have modified the teachings of Korpiu related providing additional supplementary services in the H.323 systems in order to distinguish the added supplementary services from the existing standard H.450.x.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

- a. Shaffer (US 6738343 B1) entitled: "System and method for utilizing direct user signaling to enhance fault tolerant H.323 systems"
- b. Shaffer et al. (US 6693874 B1) entitled: "System and method for enabling fault tolerant H.323 systems"
- c. Li et al. (US 6636508 B1) entitled: "Network resource conservation system"
- d. Glitho et al. (US 6614784 B1) entitled: "System and method for providing supplementary services (SS) in an integrated telecommunications network"
- e. Christie (US 6430176 B1) entitled: "Multimedia channel management through PSTN signaling"
- f. Trumbull. (US 6118763 A) entitled: "Transmission of voice over an asynchronous network"

NON PATENT DOCUMENTS

- a. Kumar et al, "Supplementary Services in the H.323 IP Multimedia", Communications Magazine, IEEE, Volume: 37, Issue: 7, July 1999, Pages: 118 - 125

2.

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3. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on Monday- Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (571) 272-3925.

Yemane M. Gerezgiher
AU: 2144

MARC D. THOMPSON
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PRIMARY EXAMINER
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